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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,282	06/16/2005	Roger Lahille	434299-729	2637
46188	7590	12/03/2009	EXAMINER	
Nixon Peabody LLP P.O. Box 60610 Palo Alto, CA 94306				PALABRICA, RICARDO J
ART UNIT		PAPER NUMBER		
3663				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/539,282	LAHILLE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Rick Palabrica	3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 7/10/09 & 10/14/09.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 21,26-34 and 41-44 is/are pending in the application.  
 4a) Of the above claim(s) 26-34 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 21 and 41-44 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____ .

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's 7/10/09 submission, as corrected by the 10/14/09 submission, which directly amended claim 21, 26-28, 33, 34, and 41-44, canceled claims 23, 45 and 46, and traversed the rejection of claims in the 4/10/09 Office action, has been entered.

### ***Election by Original Presentation***

MPEP 821.03 states:

*"Claims added by amendment following action by the examiner, MPEP § 818.01, § 818.02(a), to an invention other than previously claimed, should be treated as indicated by 37 CFR 1.145.*

37 CFR 1.145. Subsequent presentation of claims for different invention.

*If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144."*

2. In the instant case, the examiner is entering the amendment.

Amended claims 26-28, 33 and 34 are directed to an invention that is independent or distinct from the invention originally claimed for the following reason:

Applicant elected Species C (Figs. 12-14) for examination. Claim 46 recites the limitation, “a plurality of second clamping members selectively pivotable between a retracted and an extended position” For Species C, the second clamping members are screws 119 that are not pivotable because there is no pin on which a screw turns (see Fig. 12 and page 29, lines 19+ of the specification).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits.

Accordingly, claims 26-28, 33 and 34 are withdrawn from consideration as being directed to a non-elected invention. Claims 21 and 41-44 are examined in this Office action.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 21 and 41-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 21 recites, “[a] fastening device for securing at least one fuel assembly ...”.

The clause “at least one” means one or more. The new matter pertains to the device securing more than one fuel assembly.

The same remark applies to claim 41 and the recited, “transport basket configured to receive the at least one fuel assembly.”

4. Claim 21 and 41-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is neither an adequate description nor enabling disclosure for a device securing more than one fuel assembly or transport basket configured to receive more than one fuel assembly.

5. Claim 21 and 41-44 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a device securing one fuel assembly or transport basket configured to receive one fuel assembly, does not reasonably provide enablement for a device securing more than one fuel assembly or transport basket configured to receive more than one fuel assembly. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims.

6. Claims 21 and 41-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 is vague, indefinite and incomplete and its metes and bounds cannot be determined because the claim is inconsistent with the specification in regard to the number of fuel assemblies that the device can secure or the transport basket can receive.

Claim 21 recites in the preamble the subcombination of a “fastening device” that is inconsistent with the body of the claim that recites limitations directed to the combination of the fastening device and fuel assembly. Note the limitation, “connecting device located above the upper end piece of the fuel assembly”, which limitation positively recites the upper end piece, and defines the connecting device in terms of the position of the upper end piece, whose dimensions are undefined in the claim. This inconsistency presents the question as to whether the claim recites a combination or subcombination. There is insufficient antecedent basis for the limitation that is directed to the combination rather than to the subcombination because a fuel assembly is not an inherent component of a fastening device.

The same remark applies to claim 41 and the recited “control device positioned above the open end of the transport basket.”

Note: The above are just a few examples of the numerous inconsistencies between the preamble and body of the claims. Applicant must thoroughly review the claims to correct these deficiencies.

7. In the following sections, the examiner interprets the claims such that any limitation that refers to the fuel assembly or the transport basket is recited in terms of a capability to perform, e.g., "a single connecting device locatable above an upper end piece of the fuel assembly."

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 21 and 41-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Buchalet (U.S. 4,244,616)

As to claim 21, applicant's claim language reads on Buchalet as follows (e.g., see Figs. 1-4): a) "single connecting device" reads on the tool having parts 1, 2 and 3; b) "first clamping members" reads on pivoting fingers 52 and 53.

This tool is capable of being located (i.e., locatable) above an upper end piece of a fuel assembly. The claim neither defines the size nor the shape of the fuel assembly or its upper end piece. Absent such definition, the examiner interprets the claim broadly and reads it on any and all upper end pieces above which the tool of Buchalet can be located.

Fingers 52 and 53 are selectively pivotable between a retracted and an extended position.

The claims are replete with statements that are either essentially method limitations or statements of intended or desired use. For example, "for securing at least one fuel assembly in a housing of a transport basket ...", "when the first clamping members are in the retracted position ...", "to suspend the fuel assembly within the transport basket", etc. These clauses, as well as other statements of intended use do not serve to patently distinguish the claimed structure over that of the reference, as long as the structure of the cited references is capable of performing the intended use. ( Note also that "housing" and "fuel assembly" are parts of the statement of intended or desired use of the fastening device).

See MPEP 2111-2115. See also MPEP 2114 that states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647.

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531.

[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

The system in the cited reference is capable of being used in the same manner and for the intended or desired use as the claimed invention. Note that it is sufficient to show that said capability exists, which is the case for the cited reference.

Also, the recitation that an element is "configured to" perform or "configured for" performing a function or "adapted for use" does not constitute a limitation in any patentable sense, i.e., it only requires the capability to perform (e.g., see *In re*

*Hutchison*, 69 USPQ 138 69, or *National Presto Indus. V. West Bend Co.*, 76 F.3d 1185 (Fed. Cir. 1996). The apparatus in the cited reference enables or permits the function recited in the claims to take place, and therefore meets the claim limitations.

As to claims 41 and 43, applicant's claim language reads on Buchalet as follows:

a) "control device" reads on actuating device 29 (see Fig. 1 and col. 6 lines 15+); b) "claw mechanism" reads on fingers 52 and 53

As to claim 42, applicant's claim language, "pin guide having a stop surface" reads on either one of horizontal axles 21, 22, which are capable of coming in contact with the upper end piece of a fuel assembly within the transport basket.

As to claim 44, applicant's claim language, "nut" reads on cam 50.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. References B-D further illustrate prior art.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rick Palabrica whose telephone number is 571-272-6880. The examiner can normally be reached on 6:00-4:30, Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rick Palabrica/  
Primary Examiner, Art Unit 3663

December 1, 2009